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CASE QA0238 NP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BARRISH ET AL.

APPLICATION NO: 10/027,982

FILED: DECEMBER 20, 2001

FOR: THIAZOLYL INHIBITORS OF TEC FAMILY TYROSINE KINASES

Art Unit: 1626

Examiner: Rebecca L. Anderson

TECH CENTER 1600/2900

APR 22 2002

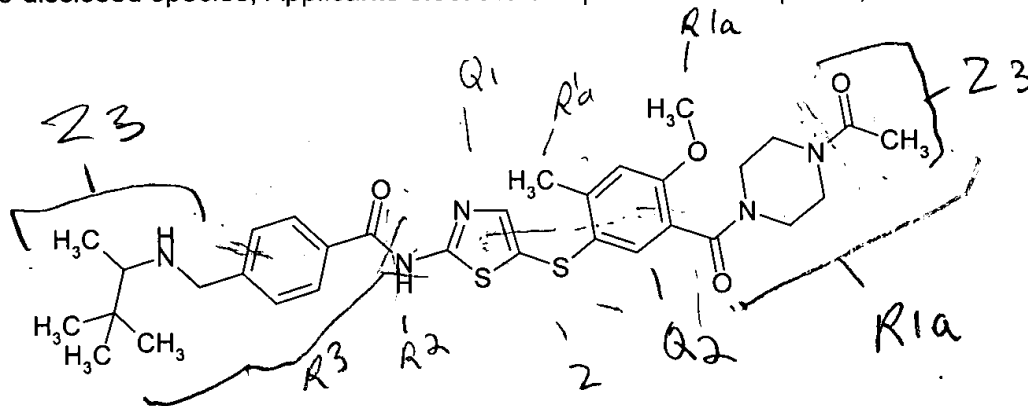
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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement dated March 11, 2002 Applicants elect the invention of Group I (claims 1-19) with traverse. In response to the requirement that Applicants elect a single disclosed species, Applicants elect the compound of Example 76, which has the structure



Claims 1-14 and 16-19 read on the elected species.

R1-n
R2
where n = one

TRAVERSE

The Examiner has taken the position that because the claimed compounds are capable of more than one use, "separate search considerations are involved, which would impose a burden if unrestricted." (Office Action at page 2). Applicants respectfully submit that proper support for a restriction has not been articulated by the Examiner.


Applicants do not understand what "separate search considerations" are involved here, as any search on the compounds themselves will necessarily uncover the known uses of these compounds—separate searches would not be required. Moreover, to properly restrict a case, the Examiner must establish that a **serious** burden would result absent restriction. Applicants submit that Examiner has not established that such is the case here. As clearly stated in the MPEP:

If the search and examination of an entire application can be made without **serious** burden, the examiner **must examine it on the merits**, even though it includes claims to independent or distinct inventions.

MPEP §803 (emphases added). Accordingly, Applicants respectfully request that the Examiner withdraw the restriction requirement and examine the entire application on the merits.

Respectfully submitted,

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